

REMARKS

In the non-final Office Action, the Examiner rejected claims 1, 3, 4, 8, 16, 17, 22-26, and 36-40 under 35 U.S.C. § 103(a) as unpatentable over Barham et al. (U.S. Patent No. 6,721,371) in view of Schier et al. (U.S. Patent Application Publication No. US 2002/0118739); rejected claims 5-7, 13, 27-29, and 33 under 35 U.S.C. § 103(a) as unpatentable over Barham et al. in view of Schier et al. and Quigley et al. (U.S. Patent No. 6,650,624); rejected claims 14, 15, 34, and 35 under 35 U.S.C. § 103(a) as unpatentable over Barham et al. in view of Schier et al., Quigley et al., and Peyrovian (U.S. Patent No. 5,768,682); and rejected claims 9, 10, 12, and 30-32 under 35 U.S.C. § 103(a) as unpatentable over Barham et al. in view of Schier et al., Quigley et al., and Applicant's allegedly admitted prior art.

By this Amendment, Applicant amends claim 36 to improve form. Claims 1, 3-10, 12-17, and 22-40 remain pending.

Initially, Applicant submits that Schier et al. is not prior art to the present application under any section of 35 U.S.C. § 102. Applicant's application has an effective filing date of March 6, 2000, by claiming priority to U.S. Provisional Application, Serial No. 60/187,194, which is earlier than any date provided under 35 U.S.C. § 102. The provisional application provides support for the claimed invention.

35 U.S.C. § 102 recites:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of

the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

The 35 U.S.C. § 102(a) date of the Schier et al. document is October 19, 2000 based on the publication date of the corresponding PCT application. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(a) because October 19, 2000 is not prior to Applicant's effective filing date of March 6, 2000.

With regard to 35 U.S.C. § 102(b), the Schier et al. document was not patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to Applicant's effective filing date of March 6, 2000. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(b).

With regard to 35 U.S.C. § 102(c), the Schier et al. document does not provide evidence that Applicant abandoned his invention. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(c).

With regard to 35 U.S.C. § 102(d), the Schier et al. document does not provide evidence that Applicant's invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by Applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(d).

With regard to 35 U.S.C. § 102(e), Applicant notes that the above-cited section of 35 U.S.C. § 102(e) is not applicable here. As explained in M.P.E.P. 706.02(a):

No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e) in accordance with the last sentence of the effective date provisions of Pub. L. 107-273. Patents issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application.

The provision of 35 U.S.C. § 102(e) in effect before November 29, 2000 stated:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Under this provision of 35 U.S.C. § 102(e), the 35 U.S.C. § 102(e) date of the Schier et al. document is October 3, 2001, which is later than Applicant's effective filing date of March 6, 2000. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(e).

With regard to 35 U.S.C. § 102(f), the Schier et al. document does not provide evidence that Applicant did not himself invent the subject matter sought to be patented. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(f).

With regard to 35 U.S.C. § 102(g), the Schier et al. document does not provide evidence that Applicant's invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. Thus, Schier et al. does not qualify as prior art under 35 U.S.C. § 102(g).

Because the Schier et al. document does not qualify as prior art under any section of 35 U.S.C. § 102, the Schier et al. document cannot be used in a rejection under 35 U.S.C. § 103. Thus, any rejection under 35 U.S.C. § 103 based on the Schier et al. document is improper. Because all of the Examiner's rejections were based on the Schier et al. document, Applicant respectfully submits that the Examiner has not established a prima facie basis to deny patentability of Applicant's claimed invention.

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of the application and the timely allowance of the pending claims.

As Applicant's remarks with respect to the Examiner's rejections overcome the rejections, Applicant's silence as to certain assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to dispute these assertions/requirements in the future.

If the Examiner believes that the application is not now in condition for allowance,

Applicant respectfully requests that the Examiner contact the undersigned to discuss any outstanding issues.

To the extent necessary, a petition for an extension of time under 35 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY SNYDER, LLP

By: /Paul A. Harrity/

Paul A. Harrity

Reg. No. 39,574

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11350 RANDOM HILLS ROAD
SUITE 600
FAIRFAX, VIRGINIA 22030
TELEPHONE: 571-432-0800
FACSIMILE: 571-432-0808